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SERIAL NUMBER	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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07/875,003 04/24/92 BEDNORZ J Y0987-074X

EXAMINER

BOYD, J

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ART UNIT

PAPER NUMBER

1105

DATE MAILED: 11/25/92

This is a communication from the Patent and Trademark Office of your application.
COMMERCIAL REFERENCE: 11/25/92

☒ This application has been examined ☐ Responsive to communication filed on _____ ☐ This action is made final.

A shortened statutory period for response to this action is set to expire 3 month(s), _____ days from the date of this letter.
Failure to respond within the period for response will cause the application to become abandoned. 35 U.S.C. 133

Part I THE FOLLOWING ATTACHMENT(S) ARE PART OF THIS ACTION:

- | | |
|---|--|
| 1. <input type="checkbox"/> Notice of References Cited by Examiner, PTO-892. | 2. <input type="checkbox"/> Notice re Patent Drawing, PTO-848. |
| 3. <input type="checkbox"/> Notice of Art Cited by Applicant, PTO-1449. | 4. <input type="checkbox"/> Notice of Informal Patent Application, Form PTO-152. |
| 5. <input type="checkbox"/> Information on How to Effect Drawing Changes, PTO-1474. | 6. <input type="checkbox"/> _____ |

Part II SUMMARY OF ACTION

1. ☒ Claims 24-26, 86-90 + 96-108 are pending in the application.

Of the above, claims _____ are withdrawn from consideration.

2. ☒ Claims 1-23, 27-85, 91-95 have been cancelled.

3. ☐ Claims _____ are allowed.

4. ☒ Claims 24-26, 86-90, 96-108 are rejected.

5. ☐ Claims _____ are objected to.

6. ☐ Claims _____ are subject to restriction or election requirement.

7. ☐ This application has been filed with Informal drawings under 37 C.F.R. 1.85 which are acceptable for examination purposes.

8. ☐ Formal drawings are required in response to this Office action.

9. ☐ The corrected or substitute drawings have been received on _____. Under 37 C.F.R. 1.84 these drawings are ☐ acceptable ☐ not acceptable (see explanation or Notice re Patent Drawing, PTO-848).

10. ☐ The proposed additional or substitute sheet(s) of drawings, filed on _____ has (have) been ☐ approved by the examiner. ☐ disapproved by the examiner (see explanation).

11. ☐ The proposed drawing correction, filed on _____, has been ☐ approved. ☐ disapproved (see explanation).

12. ☒ Acknowledgment is made of the claim for priority under U.S.C. 119. The certified copy has ☒ been received ☐ not been received
☐ been filed in parent application, serial no. _____; filed on _____.

13. ☐ Since this application appears to be in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11; 453 O.G. 213.

14. ☐ Other

EXAMINER'S ACTION

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1. This is a supplemental office action necessary because the Examiner failed to address claims 24-26 and 86-90.

2. The following is a quotation of the first paragraph of 35 U.S.C. § 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. The specification is objected to under 35 U.S.C. § 112, first paragraph, as failing to provide an enabling disclosure commensurate with the scope of the claims.

4. The specification is objected to for the reasons set forth in paragraphs 6-7 in the previous office action (paper no. 33). The present specification is only enabled for compositions comprising $\text{Ba}_x\text{La}_{5-x}\text{Cu}_5\text{O}_y$.

5. Claims 24-26 and 86-90 [in addition to claims 96-108] are rejected under 35 U.S.C. § 112, first paragraph, for the reasons set forth in the objection to the specification.

6. Claims 86-87 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. What is meant by the term "rare earth-like element" (see claim 86)?

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8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. § 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

9. Claims 24-26 and 86-90 [in addition to claims 96-108] are rejected under 35 U.S.C. § 102(a) as being anticipated by Asahi Shinbum.

10. This reference is relied upon for the reasons set forth in paragraph 16 of the previous office action (paper no. 33).

11. The following is a quotation of 35 U.S.C. § 103 which forms the basis for all obviousness rejections set forth in this Office action:

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Subject matter developed by another person, which qualifies as prior art only under subsection (f) or (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

12. The "person having ordinary skill" in this art has the capability of understanding the scientific and engineering

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principles applicable to the claimed invention. The references of record in this case reasonably reflect this level of skill.

13. Claims 24-26 and 86-90 [in addition to claims 96-108] are rejected under 35 U.S.C. § 103 as being unpatentable over Asahi Shinbum. The reference is relied upon for the reasons set forth in paragraph 20 of the previous office action (paper no. 33).

14. All other rejections remain as set forth in the action dated August 26, 1992.

15. A new Shortened Statutory Period is set herein which applies both to this action and the office action dated August 26, 1992.

14. Any evidence to be presented in accordance with 37 CFR 1.131 or 1.132 should be submitted before final rejection in order to be considered timely. It is anticipated that the next Office Action may be a final rejection.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John Boyd whose telephone number is (703) 308-2519.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0661.

JB
J. Boyd
November 24, 1992



PAUL LIEBERMAN
SUPERVISORY PRIMARY EXAMINER
ART UNIT 115